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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/870,475 | 06/01/2001 | Toru Kurokawa | 0649-0786P | 1027 |

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| EXAMINER |
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HUNTSINGER, PETER K

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| ART UNIT | PAPER NUMBER |
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2625

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|--|--|--|
| Office Action Summary | Application No. 09/870,475 | Applicant(s) KUROKAWA ET AL. | |
| | Examiner Peter K. Huntsinger | Art Unit 2625 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 7-19, 20, 25-29, and 33-35 is/are rejected.
- 7) ☒ Claim(s) 3-5, 21-24, and 30-32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see the amendment, filed 7/5/06, with respect to the rejection(s) of claim(s) 1-32 under Fukunaga et al. in view of Hirai have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of McIntyre et al.

Claim Rejections - 35 USC § 101

Claims 10-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 10 and 16 are drawn to a computer implemented process that merely manipulates data or an abstract idea, or merely solves a mathematical problem without a limitation to a practical application in the technological arts.

In order for a claimed invention to accomplish a practical application, it must produce a "useful, concrete and tangible result" *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02 (see MPEP 2106.II.A). A practical application can be achieved through recitation of "a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan", or "limited to a practical application within the technological arts" (MPEP 3106 IVB2(b)). Currently, claims 10 and 16 meet neither

of these criteria. In order for the claimed process to produce a “useful, concrete and tangible” result, recitation of one or more of the following elements is suggested:

- The manipulation of data that represents a physical object or activity transformed from outside the computer (MPEP 2106 IVB2(b)(i)).
- A recitation of a physical transformation outside the computer, for example in the form of pre or post computer processing activity (MPEP 2106 IVB2(b)(i)).
- A direct recitation of a practical application in the technological arts (MPEP 2106 IVB2(b)(ii)).

In addition, Claims 10 and 16 are drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

“Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer.”

“Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure’s functionality to be realized.”

Claims 10 and 16, while defining a recording medium, does not define a “computer-readable medium” and is thus non-statutory for that reason. A recording medium can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim

to embody the program on "computer-readable medium" in order to make the claim statutory.

In summary, claims 10 and 16 need to recite a useful, concrete, and tangible result AND recite a computer-readable medium to be considered statutory.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The numerous commas make the claim unclear as to which actions are preformed by the order receiving server and which actions are preformed by the terminal unit.

4. Claims 8 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unknown how said designated print-order acceptor information (stored on the recording medium as disclosed by the independent claim) can specify a request of creation of said recording medium. The designated print-order acceptor information must exist on the recording medium as claimed in the independent claim but therefore cannot specify creation of the medium it exists on.

5. Claims 9 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. The applicant's specification discloses the mountable recordable medium as a CD-R and discloses the limitation of renewing said server-connection address information and said designated print-order acceptor information as rerecording. A CD-R cannot be rerecorded more than once and thus the limitation is impossible.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 2, 7-11, 13-17, 19, 20, 25, and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by McIntyre et al. Patent 7,016,868.

Referring to claims 1, 10, 20, and 29, McIntyre et al. disclose an image print order system using a network, comprising: an order receiving server which is connected to said network (server 35 of Fig. 2, col. 6, lines 64-66); and a terminal unit connectable to said network (computer 30 of Fig. 2, col. 6, lines 49-63), to which a recording medium can be mounted (image storage device 24 of Fig. 1, col. 6, lines 15-20); wherein said terminal unit, when the recording medium, storing a digital image data, a server-connection address information (col. 6, lines 2-5, 25-29), and a designated print-order

acceptor information (col. 13, lines 41-52), is mounted to the terminal unit, said terminal unit is connected to said order receiving server based on said server-connection address information so as to transmit said designated print-order acceptor information and at least a part of said digital image data at the same time to said order receiving server (col. 6, lines 25-36, col. 13, lines 41-52); and wherein said order receiving server outputs a print command data based on the received digital image data, and a command data by which a receiver of an order in accordance with said designated print-order acceptor information can receive an image print that is printed based on said print command data (col. 8, lines 44-49). The ID as disclosed by McIntyre (col. 13, lines 41-52) reads on the designated print-order acceptor information because it is information utilized by the entity that receives the print order.

Referring to claims 2, 11, and 17, McIntyre et al. disclose wherein said order receiving server is a WWW server (server 35 of Fig. 2, col. 6, lines 64-66).

Referring to claims 7 and 13, McIntyre et al. disclose wherein said server-connection address information and designated print-order acceptant information are recorded when the digital image data is recorded in said recording medium (col. 8, lines 8-18).

Referring to claims 8, 14, and 19, McIntyre et al. disclose wherein said designated print-order acceptant information is data that specifies a receiver of request to whom creation of said recording medium has been requested (col. 13, lines 41-52).

Referring to claims 9 and 15, McIntyre et al. disclose wherein said server-connection address information and said designated print-order acceptant information are renewable (col. 8, lines 8-18).

Referring to claim 16, McIntyre et al. disclose a recording medium providing method for providing a recording medium on which digital image data have been recorded, wherein at least one of digital image data obtained by developing a photographic film before development and carrying out a photoelectrical conversion of the image after development, digital image data obtained by carrying out a photoelectrical conversion of the photographic film after development or an image of an image print, and digital image data recorded on other recording mediums is recorded on a single recording medium (col. 5, lines 48-58), and there is included a step of recording on said recording medium connection address data to a print order receiving server connected to a network (col. 6, lines 2-5, 25-29),, designated print-order acceptant information (col. 13, lines 41-52), and data for causing said terminal unit to connect to said order receiving server through said network when the recording medium is mounted to a terminal unit and to transmit said designated print-order acceptant information to said order receiving server (col. 6, lines 25-36, col. 13, lines 41-52). The ID as disclosed by McIntyre (col. 13, lines 41-52) reads on the designated print-order acceptor information because it is information utilized by the entity that receives the print order.

Referring to claim 25, McIntyre et al. disclose wherein the requested service shop originally records its data as the requested service shop data to the recording medium (col. 8, lines 8-18).

8. Claims 26-28 and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over McIntyre et al. Patent 7,016,868, as applied to claim 20 above, and further in view of Hurtado et al. Patent 6,611,812.

Referring to claim 26, McIntyre et al. disclose mounting the recording medium, but does not disclose expressly an automatic run program. Hurtado et al. disclose automatically executing the automatic run program when the recording medium is mounted to the terminal to connect to the selected print service receiving server (col. 84, lines 45-60). McIntyre et al. and Hurtado et al. are combinable because they are from the same field computer systems. At the time of the invention, it would have been obvious to a person of ordinary skill to automatically run a program when a CD is inserted. The motivation for doing so would have been to eliminate the need for the user to manually load the program on the CD. Therefore, it would have been obvious to combine Hurtado et al. with McIntyre et al. to obtain the invention as specified in claim 26.

Referring to claim 27, Hurtado et al. disclose the image print ordering system of claim 26, wherein the recording medium further includes a to-network connection program operated by the automatic run program (web browser, col. 84, lines 45-60).

Referring to claim 28, McIntyre et al. disclose further including a viewer program for viewing and selecting image and generating the print request data. Hurtado et al. disclose the automatic run program (col. 6, lines 25-36).

Referring to claim 33, McIntyre et al. disclose wherein the program executes an order input processing program for viewing and selecting images and generating the print request data, and wherein the program connects to the selected print service receiving server prior to running the order content input processing program (col. 6, lines 25-36).

Referring to claim 34, McIntyre et al. disclose wherein the selected print service receiving server provides the order content input processing program to the terminal through the network (col. 6, lines 25-36).

Referring to claim 35, McIntyre et al. disclose providing an order content input processing program to the terminal via the network prior to receiving the print request from the terminal, wherein the order content input processing program is executed by the terminal to generate the print request (col. 6, lines 25-36).

Allowable Subject Matter

9. Claims 3-5, 21-24, and 30-32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claims 12 and 18 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 101, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

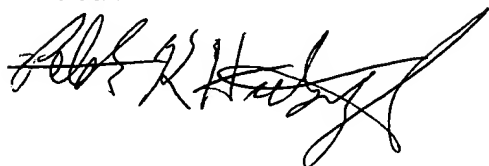
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571)272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PKH

A handwritten signature in black ink, appearing to be 'PKH' with a stylized flourish.

Kimberly A. Williams

KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER